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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,504	07/25/2003	David A. Bulpett	B03-50	3239

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

an

Office Action Summary	Application No. 10/627,504	Applicant(s) BULPETT ET AL.	
	Examiner David Buttner	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 1-20,24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Peter '313 Patent in view of Dexter '431 or the Chu article in the Journal of Biomedical Materials Research.

Peter produces golf ball covers from a diisocyanate/polyol prepolymer and an aromatic polyamine (e.g. Example 1).

UV stabilizers such as benzotriazoles and benzophenones especially in combination with hindered amine light stabilizers can be added to color stabilize the cover (col. 10, line 54-58). Peter does not suggest benzoate stabilizers.

Alkylhydroxybenzoates are known as stabilizers for polyurethanes (see Dexter abstract; col 1 line 33). Chu actually exemplifies the inclusion of Eastman RMB (resorcinol monobenzoate) in polyurethanes (tables I and V).

It would have been obvious to use any UV stabilizer or combination thereof for use in Peter's ball.

It is assumed Peter's ball would have the required color stability, because applicant's disclosure (page 20 line 30 to page 21 line 4) indicates alkylhydroxybenzoates and phenylhydroxybenzoates would be effective.

Claims 1-20, 22-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Dewanjee WO 98/37929 Patent in view of Dexter '431 or Chu article in the Journal of Biomedical Materials Research.

Dewanjee discloses polyurethane covers for two or three piece golf balls. The polyurethane is made from a diisocyanate prepolymer and amine curative (abstract). A stabilizing package (page 12, line 11) may be included.

Alkylhydroxybenzoates are known as stabilizers for polyurethanes (see Dexter abstract; col 1 line 33). Chu actually exemplifies the inclusion of Eastman RMB (resorcinol monobenzoate) in polyurethanes (tables I and V).

It would have been obvious to use any UV stabilizer or combination thereof for use in Dewanjee's ball. It is assumed Dewanjee's ball would have the required color stability, because applicant's disclosure (page 20 line 30 to page 21 line 4) indicates alkylhydroxybenzoates and phenylhydroxybenzoates would be effective.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1- 20 and 22-26 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1- 24 of U.S. Patent No. 6949595.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent also claims golf balls having benzoate stabilizers (#7).

The benzoate can be CYASORB UV2908 (col 19 line 11) which corresponds to applicant's benzoate.

Applicant's arguments with respect to claims 1-20 and 22-26 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner
1/12/06

